

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 14  
JQ

7/18/00

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Berkeley Networks

---

Serial No. 75/366,259

---

Christopher H. Gebhardt and Elaine V. Keim for applicant.

Keith Weltsch, Trademark Examining Attorney, Law Office 102  
(Thomas Shaw, Managing Attorney).

---

Before Quinn, Walters and Wendel, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Berkeley Networks to register the mark ACTIVE SWITCH for "computer networking equipment, namely, computer hardware and computer software for operating computer networking equipment."<sup>1</sup>

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Act on the ground

---

<sup>1</sup> Application Serial No. 75/366,259, filed October 1, 1997, alleging a bona fide intention to use the mark in commerce.

that applicant's mark, if applied to the goods, would be merely descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed appeal briefs. Applicant neither filed a reply brief nor requested an oral hearing.

Applicant argues, without getting very specific, that the term sought to be registered is just suggestive. Applicant contends that while the individual terms "active" and "switch" may be commonly used in connection with computer hardware, the composite mark is not merely descriptive. Applicant further argues that issuance of a registration to it will not deprive others in the industry from using the individual terms in their usual descriptive manner. Lastly, applicant maintains that any doubt on the issue of mere descriptiveness must be resolved in applicant's favor.<sup>2</sup>

---

<sup>2</sup> In connection with its arguments to reverse the refusal, applicant submitted a computer-generated list of third-party registrations which, according to applicant, show that the term "active" is suggestive. Mere listings of third-party registrations generally are not sufficient to make the registrations of record; copies of the registrations themselves are required for that purpose. In re Classic Beverage Inc., 6 USPQ2d 1383 (TTAB 1988). The Examining Attorney properly objected to the listing on this basis, and the third-party registrations do not form part of the appeal record. We hasten to add, however, that we agree with the Examining Attorney's assessment of this evidence. That is to say, even if this

The Examining Attorney contends that the applied-for mark merely describes a feature of applicant's goods, namely, that the computer networking equipment includes a mechanical or electrical device that completes or breaks the path of electric current or sends it over a different path that adds intelligence in some manner to the signal or data that passes through it. In sum, according to the Examining Attorney, the term ACTIVE SWITCH merely describes a particular type of computer hardware or software that operates computer networking equipment. In support of the refusal to register, the Examining Attorney submitted dictionary definitions,<sup>3</sup> numerous excerpts retrieved from the NEXIS database, and excerpts from applicant's web page.

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes a quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. In re Abcor Development Corp., 588 F.2d 811, 200

---

evidence were considered, it is not persuasive of a different result in this case.

<sup>3</sup> To the extent that some of the definitions were submitted for the first time with the Examining Attorney's brief, we grant the request to take judicial notice of this matter. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods and/or services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

The term "active component," as defined in *The Internet Glossary and Quick Reference Guide* (1998), means the following:

a device that adds intelligence in some manner to the signal or data that passes through it. For example, in networking, an active hub regenerates fading input pulses into new, strong output pulses. In contrast, a passive hub is just a junction box that does not affect the passing data.

The term "switch" is defined in *Modern Dictionary of Electronics* (1997) as follows:

A mechanical or electrical device that completes or breaks the path of the current or sends it over a different path; in a computer, a device or programming technique by means of which selections are made; a device that connects, disconnects, or transfers one or more circuits.

Clearly, a "switch" is a "component" of computer networking equipment, and applicant does not dispute that its goods include switches.<sup>4</sup> In point of fact, applicant refers on its webpage to the switching technology of its products as used in computer networking systems.

In its brief, applicant states that its products are based on ATM (Asynchronous Transfer Mode) technology. The NEXIS excerpts show that the term "active switch" is used in the computer networking field, and a few articles discuss the role of active switches in ATM technology.

Examples of the NEXIS articles are as follows:

...the time it takes to get a cell through an active switch, although this form of latency would vary based on the volume and distribution of the traffic at the moment.

*Datamation* (February 15, 1995)

Another thing to consider is that ATM requires an active switch in the middle of all the nodes, whereas the Fast Ethernet standard can use a simple repeater.

*LAN Times* (November 23, 1992)

A network using the active switches responds to changing bandwidth and routing conditions more quickly than a passive-switch network.

*Government Computer News* (April 29, 1988)

---

<sup>4</sup> In connection with this point, we note applicant's remark that "because the mark is associated with hardware and software products and products that bundle both hardware and software other than Applicant's 'switch' products, the ACTIVE SWITCH mark is suggestive..." (brief, p. 6)

The last-referenced article also refers to the switches as "handl[ing] mixed voice, data, facsimile, image and digitized video traffic." As the Examining Attorney notes, applicant's products, according to applicant, "enable the transfer of voice, video and data across computer networks." (brief, p. 9)

The evidence of record convinces us that the term "active switch" has a recognized meaning in the computer networking field. A purchaser encountering ACTIVE SWITCH for applicant's computer networking hardware and software would be immediately informed that the products featured active switches.

As pointed out by the Examining Attorney, it is irrelevant that applicant's goods may include other types of products that are not switches. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982). Further, the fact that terms may have different meanings in other contexts is not controlling on the question of mere descriptiveness. In re Bright-Crest, Ltd., supra.

In view of the above, the term ACTIVE SWITCH, if used in connection with applicant's computer hardware and computer software for operating computer networking equipment, would be merely descriptive thereof.

**Ser No.** 75/366,259

Decision: The refusal to register is affirmed.

T. J. Quinn

C. E. Walters

H. R. Wendel  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

**Ser No.** 75/366,259